



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,039	12/01/2000	Yi-Tae Cho	5000-1-144	2571

33942 7590 03/15/2004

CHA & REITER, LLC
210 ROUTE 4 EAST STE 103
PARAMUS, NJ 07652

EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,039

Applicant(s)

CHO, YI-TAE

Examiner

Azizul Choudhury

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/01/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Claim Objections

Claims 1 and 3 are objected to because of the following informalities:

- Claim 1, second line states the term "E-main," it is believed that this term should be "E-mail".
- Claim 3, first line states the term "E-main," it is believed that this term should be "E-mail".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hyde-Thomson (US Pat No: US005717742A).

1. With regards to claim 1, Hyde-Thomson teaches a method for notifying a voice message reception to a terminal capable of receiving an E-mail when a message is received in a voice mail system, the method comprising the steps of:

- Storing a voice message received at the voice mail system;

- Transmitting the voice message and information related to the voice message to a mail server according to a previously registered E-mail address; and
- Transmitting the voice message and the information related to the voice message to the terminal capable of receiving an E-mail according to the E-mail address registered in the mail server; wherein the information related to the voice message is included in a message part of the E-mail and the voice message is attached to the E-mail in the form of a file, when transmitting the voice message and the information related to the voice message to the mail server.

(Hyde-Thomson teaches a design where a message is received by a phone system. The message is converted into a format that can be attached to an email message and is sent to a computer to be accessed by the user (column 3, lines 35-53, Hyde-Thomson). A computer capable to receive emails such as the one in Hyde-Thomson's design is equivalent to the claimed terminal capable of receiving emails. In addition, an email server is used in any email system and hence must exist in Hyde-Thomson's design and is used for the claimed purposes as well).

2. With regards to claim 2, Hyde-Thomson teaches a method further comprising the step of reproducing the received voice message in the terminal capable of receiving an E-mail by executing the file attached to the E-mail, when the terminal capable of receiving an E-mail receives the voice message and the information related to the voice

Art Unit: 2143

message (Hyde-Thomson's design allows a user to play the phone message through the computer where the email was received (column 4, lines 26-36, Hyde-Thomson)).

3. With regards to claim 3, Hyde-Thomson teaches a method for notifying a voice message reception to a terminal capable of receiving an E-mail when a message is received in a voice mail system, the method comprising the steps of:

- Registering an E-mail address in the voice mail system using a telephone;
 - Storing a voice message received at the voice mail system;
 - Determining whether an E-mail notification function is set;
 - Transmitting the voice message and information related to the voice message to an E-mail server according to a registered E-mail address, when the E-mail notification function is set; and
 - Transmitting the voice message and the information related to the voice message to the terminal capable of receiving an E-mail according to the registered E-mail address; wherein the information related to the voice message is included in a message part of the E-mail and the voice message is attached to the E-mail in the form of a file, when transmitting the voice message and the information related to the voice message to the mail server.
- (Hyde-Thomson teaches a design where a message is received by a phone system. The message is converted into a format that can be attached to an email message and is sent to a computer to be accessed by the user (column 3, lines 35-53, Hyde-Thomson). A computer capable to receive emails such as the one in Hyde-Thomson's design is equivalent to the claimed terminal

capable of receiving emails. In addition, an email server is used in any email system and hence must exist in Hyde-Thomson's design and is used for the claimed purposes as well. Also, with regards to setting the email notification setting on, Hyde-Thomson's design offers various options as to how to answer a call. Playing it through an email attachment on a computer is just one such possibility permitted by Hyde-Thomson's design).

4. With regards to claim 4, Hyde-Thomson teaches a method further comprising the step of reproducing the received voice message in the terminal capable of receiving an E-mail by executing the file attached to the E-mail, when the terminal capable of receiving an E-mail receives the voice message and the information related to the voice message (Hyde-Thomson's design allows a user to play the phone message through the computer where the email was received (column 4, lines 26-36, Hyde-Thomson)).

5. With regards to claim 5, Hyde-Thomson teaches a method further comprising the steps of:

- After storing the received voice message, determining whether an SMS (Short Message Service) function is set; and
- Notifying the terminal of message reception when the SMS function is set. (Hyde-Thomson's design allows for peer-to-peer messaging (column 3, line 59, Hyde-Thomson). Hence the means for SMS are present).

6. With regards to claim 6, Hyde-Thomson teaches a method wherein the information related to the voice message includes date and time when the voice message is received, a phone number of a person who has left the voice message, and

the total number of the voice messages stored in the voice mail system (Hyde-Thomson's design provides the date of each message and which messages have voice messages affiliated with them (column 15, line 59 – column 16, line 4, Hyde-Thomson). The means hence are present to determine how many email messages are present with voice message attachments. In addition, Figure 17 illustrates that the phone number from which the voice message was received from is also displayed as part of the email).

7. With regards to claim 7, Hyde-Thomson teaches a method wherein the information related to the voice message includes date and time when the voice message is received, a phone number of a person who has left the voice message, and the total number of the voice messages stored in the voice mail system (Hyde-Thomson's design provides the date of each message and which messages have voice messages affiliated with them (column 15, line 59 – column 16, line 4, Hyde-Thomson). The means hence are present to determine how many email messages are present with voice message attachments. In addition, Figure 17 illustrates that the phone number from which the voice message was received from is also displayed as part of the email).

8. With regards to claim 8, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a personal computer (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Computers are such client machines. This design is able to have PCs (column 3, line

39, Hyde-Thomson), which is a type of computer. Furthermore, Figure 1 illustrates the existence of PCs in the design).

9. With regards to claim 9, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a personal computer (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Computers are such client machines. This design is able to have PCs (column 3, line 39, Hyde-Thomson), which is a type of computer. Furthermore, Figure 1 illustrates the existence of PCs in the design).

10. With regards to claim 10, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a personal computer (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Computers are such client machines. This design is able to have PCs (column 3, line 39, Hyde-Thomson), which is a type of computer. Furthermore, Figure 1 illustrates the existence of PCs in the design).

11. With regards to claim 11, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a Personal Digital Assistant (PDA) (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines

Art Unit: 2143

with the appropriate hardware and software installed to permit email transmission and reception. Computers are such client machines. PDAs are a type of computer).

12. With regards to claim 12, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a Personal Digital Assistant (PDA) (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Computers are such client machines. PDAs are a type of computer).

13. With regards to claim 13, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a Personal Digital Assistant (PDA) (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Computers are such client machines. PDAs are a type of computer).

14. With regards to claim 14, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a mobile phone which can support a radio data communication service (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Mobile phones are such client machines).

Art Unit: 2143

15. With regards to claim 15, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a mobile phone which can support a radio data communication service (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Mobile phones are such client machines).

16. With regards to claim 16, Hyde-Thomson teaches a method wherein the terminal capable of receiving an E-mail is a mobile phone which can support a radio data communication service (Hyde-Thomson's design allows for emails to be delivered through email systems (column 3, lines 35-53, Hyde-Thomson). Email systems typically deliver email messages to client machines with the appropriate hardware and software installed to permit email transmission and reception. Mobile phones are such client machines).

17. With regards to claim 17, Hyde-Thomson teaches a method wherein the E-mail address is registered in the voice mail system by recognizing a voice of the user (Hyde-Thomson discloses a design where an email is sent with the voice message to the user (column 4, lines 6-9, Hyde-Thomson). In addition, the disclosure further states that the voice gateway PC (viewed as being part of the claimed voice mail system) converts the extension number of the voice message to an email address (column 4, lines 1-6, Hyde-Thomson). Hence, the email address must be registered).

Art Unit: 2143

18. With regards to claim 18, Hyde-Thomson teaches a method wherein the information related to the voice message includes date and time when the voice message is received, a phone number of a person who has left the voice message, and the total number of the voice messages stored in the voice mail system (Hyde-Thomson's design provides the date of each message and which messages have voice messages affiliated with them (column 15, line 59 – column 16, line 4, Hyde-Thomson). The means hence are present to determine how many email messages are present with voice message attachments. In addition, Figure 17 illustrates that the phone number from which the voice message was received from is also displayed as part of the email).

19. With regards to claim 19, Hyde-Thomson teaches a method wherein the information related to the voice message includes date and time when the voice message is received, a phone number of a person who has left the voice message, and the total number of the voice messages stored in the voice mail system (Hyde-Thomson's design provides the date of each message and which messages have voice messages affiliated with them (column 15, line 59 – column 16, line 4, Hyde-Thomson). The means hence are present to determine how many email messages are present with voice message attachments. In addition, Figure 17 illustrates that the phone number from which the voice message was received from is also displayed as part of the email).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is 703-305-7209. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100